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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,932	08/29/2001	Naruhito Kondo	016887-1049	7231

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FOLEY AND LARDNER  
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WASHINGTON, DC 20007

EXAMINER
NICOLAS, WESLEY A

ART UNIT	PAPER NUMBER
1742	

DATE MAILED: 07/11/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/940,932		<b>Applicant(s)</b> KONDO ET AL.	
	<b>Examiner</b> Wesley A. Nicolas		<b>Art Unit</b> 1742	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 27 June 2003.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-12 and 17-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-12, 17-25 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All    b) ☐ Some    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 09/393,317.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

### DETAILED ACTION

This is in response to the Amendment dated June 27, 2003. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12 and 17-25 are currently pending in this application.

#### Claim Rejections - 35 USC § 103

1. Claims 1-7 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilchrist (5,322,545), and further in view of Tomczuk et al. (5,009,752).

The 35 U.S.C. § 103 rejections of claims 1-7 and 17-23 as set forth in the previous Office action have been **maintained** and are incorporated herein. Although Applicant made an amendment to the claims, said amendment does nothing to affect the rejection which already pertained to the claimed "waste."

2. Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Gilchrist - Tomczuk et al. combination, as applied to claims 1 and 17 above, and further in view of Poa et al. (5,225,051).

The 35 U.S.C. § 103 rejections of claims 8 and 24 as set forth in the previous Office action have been **maintained** and are incorporated herein. Although Applicant made an amendment to the claims, said amendment does nothing to affect the rejection which already pertained to the claimed "waste."

3. Claims 9-12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Gilchrist - Tomczuk et al. combination, as applied to claims 1 and 17 above, and further in view of Pierce et al. (5,160,367).

The 35 U.S.C. § 103 rejections of claims 9-12 and 25 as set forth in the previous Office action have been **maintained** and are incorporated herein. Although Applicant made an amendment to the claims, said amendment does nothing to affect the rejection which already pertained to the claimed "waste."

**REMARKS - Response to Arguments**

4. Applicant's arguments filed June 27, 2003, have been fully considered but they are not persuasive.

Applicant asserts that one skilled in the art would not have combined Tomczuk with Gilchrist in the fashion suggested by the Office action and that there is no motivation to combine the references because Gilchrist is directed to producing uranium per se, not in recovering uranium and plutonium from spent fuel pins as disclosed in Tomczuk.

In response, it is sufficient that the reference clearly suggests doing what Applicant's have done, such as removal of unwanted materials (*i.e.* waste) as disclosed in Gilchrist. Additionally, "Expected beneficial results are evidence of obviousness of a claimed invention, just as unexpected results are evidence of unobviousness thereof." In re Gershon, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967). Therefore, since Gilchrist suggests removal of impurities (*i.e.* unwanted materials), and

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Tomczuk teaches the removal of waste from nuclear fuel materials, there is enough of a motivation to combine Tomczuk and Gilchrist.

Applicant further asserts that even if Tomczuk and Gilchrist contained a motivation to combine, neither reference teaches electrically conductive waste contaminated with nuclear fuel materials. In response, Although Tomczuk teaches electrically conductive nuclear fuel materials contaminated with waste (col. 2, lines 11-35 and lines 66-68), this is one and the same as electrically conductive waste contaminated with nuclear fuel materials. Applicant's argument is like saying green apples are different than red apples, but they're still both apples. Tomczuk still separates the nuclear fuel materials from the waste as claimed by Applicant.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wesley Nicolas whose telephone number is (703)305-0082. The examiner can normally be reached on Mon.-Thurs. from 7am to 5pm.

The Supervisory Primary Examiner for this Art Unit is Roy King whose telephone number is (703) 308-1146.

The fax number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

ROY KING   
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

Wesley A. Nicolas

July 10, 2003